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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,214	03/15/2001	Erwin Hacker	514413-3869	6462

7590 09/20/2002

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EXAMINER	
CLARDY, S	

ART UNIT	PAPER NUMBER
1616	

DATE MAILED: 09/20/2002 7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/787,214	Hacker et al
Examiner	**Art Unit**
S. Mark Clardy	1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Jul 25, 2002* .

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-10* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

Claims 1-10 are pending in this application which has been filed under 35 USC 371 as a national stage application of PCT/EP99/06937, filed September 20, 1999. This application lacks unity of invention under 37 CFR 1.475 (MPEP 1850, 1893.03(d)).

This application contains claims directed to the following patentably distinct species of the claimed invention: herbicidal compositions comprising:

A. An aminotriazinyl herbicide

B. A second herbicidal component (see seven page list in claim 1).

In the response filed July 25, 2002, applicants elected the composition comprising the following herbicides:

A2. N-(1-cyclopropyl-4-phenylbutyl)-6-(1-fluoro-1-methylethyl)-1,3,5-triazine-2,4-diamine

B1.3.3 Fenoxaprop.

Again, upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The abstract of the disclosure is objected to because it does not fit on one page and it also refers to claim 1 for material that should appear in the abstract. Correction is required. See MPEP § 608.01(b).

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, i.e., the use of the herbicide combinations.

Claims 2, 3, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The substituent designations are inconsistent in the claims. Note that the R^2 group of claim 3 corresponds to the R^5 group of claim 2, in which R^2 is instead on the amino group.

Claim 9 is a method claim dependent on the method of claim 6 which is a composition claim. It appears that it was intended to depend from either claim 7 or 8.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Giencke et al (US 6,239,071) and Hoechst (PCT WO 98/34925).

First it is noted that applicants have stated on the record that the aminotriazinyl herbicides herein are known and that they have been described in the prior art (specification, p. 27).

Giencke et al teach that aminotriazine herbicides may be combined with various other herbicides including fenoxaprop (col 19, lines 9-10). Compound 99 differs from applicants' elected aminotriazine compound in having H in place of the cyclopropyl group (R^5 of claim 2).

Hoechst teaches also that aminotriazine herbicides may be combined with various other herbicides including fenoxaprop (p. 37, lines 10-11). Compound 405 differs from applicants' elected aminotriazine compound in having $-CH_2-O-$ in place of $-CH_2-CH_2-CH_2-$ for the A substituent of claim 2.

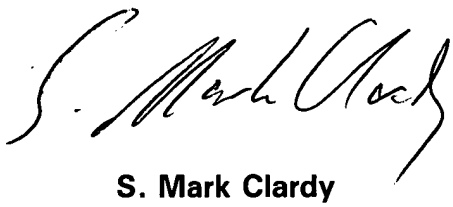
One of ordinary skill in the art would be motivated to combine these references because they teach the herbicidal utility of aminotriazine compounds and that, in spite of multiple structural variations, the herbicidal utility is retained.

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have used applicants' elected aminotriazine herbicide, in combination with a second herbicidal agent, such as fenoxaprop, to make a herbicidal composition. Further, it is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 205 USPQ 1069. Determination of appropriate concentration ranges would have been within the skill level of the ordinary artisan.

It is not seen where applicants have provided test data for the elected combination. The closest data appears to be for the combination of A1 + B1.3.3 with a safener (Example 21). Note that test data must be commensurate in scope with the scope of the claims.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103c and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.



S. Mark Clardy
Primary Examiner
AU 1616

September 19, 2002